



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q64460

Sojiro SHIOKAWA, *et al.*

Appln. No.: 09/856,372

Group Art Unit: 1624

Confirmation No.: 8305

Examiner: Brenda Libby COLEMAN

Filed: November 2, 2001

For: BENZOXAZOLE DERIVATIVES AND MEDICAMENTS COMPRISING SAID
DERIVATIVES AS ACTIVE INGREDIENT

RESPONSE UNDER 37 C.F.R. § 1.111

MAIL STOP AMENDMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Please consider the remarks below in response to the Office Action sent April 28, 2005.

Claims 1 and 18-21 are all the claims pending in the application.

The Office Action sets forth three rejections - the obviousness-type double patenting rejections at Section Nos. 4-6 (pages 2-4) of the Action. That is, in Section No. 4 at pages 2 and 3 of the Office Action, Claims 1 and 18-21 are rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over Claims 1-4 of U.S. Patent No. 6,037,342 ("US '342"). In Section No. 5 of the Office Action, Claims 1 and 18-21 are rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over Claim 3 of U.S. Patent No. 6,867,226 ("US '226"). In Section No. 6 of the Office Action, Claim 18 is rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over Claims 1-3 of U.S. Patent No. 6,552,057 ("US '057").

RESPONSE

U.S. Appln. No. 09/856,372

Applicants respectfully traverse each of the rejections. The presently claimed compound achieves unexpectedly superior results rebutting any *prima facie* case of obviousness.

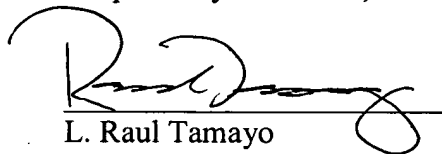
In order to prove that the claimed compound is unexpectedly superior over the compounds of each of US '342, US '226, and US '057, co-inventor Dr. Yasuo Sato conducted comparative experiments between Compound Ex. 1(b) of the present invention and Comparative Compound F, which is 5-chloro-7-methyl-2-piperazinyl benzoxazole and is disclosed in Test Example of the specification, and Comparative Compound H, which is 5,7-dimethyl-2-homopiperazinyl benzoxazole.

A description of the preparation of Comparative Compound H and results from the comparative experimentation are provided in Dr. Sato's Rule 132 Declaration, which is submitted herewith. In light of Dr. Sato's Declaration, Applicants respectfully request reconsideration and withdrawal of each of the double patenting rejections.

Reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


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WASHINGTON OFFICE

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CUSTOMER NUMBER

Date: September 28, 2005